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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,345	12/27/2006	Sergio A. Maiocchi	084342-000000US	2236
20350 7590 05/22/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
			EXAMINER RO, BENTSU	
			ART UNIT 2837	PAPER NUMBER
			MAIL DATE 05/22/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,345

Applicant(s)

MAIOCCHI, SERGIO A.

Examiner

BENTSU RO

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-53, 55-57, 64-68, 84-86 and 93-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49 and 95-100 is/are allowed.
- 6) ☒ Claim(s) 47-48, 50-53, 55-57, 64-68, 84-86, 93-94, 101-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 47, 48, 50-53, 55-57, 64-68, 84-86, 93, 94, 101-123 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rejected because of the following reasons:

- Claim 47, between line 2 and line 3, the recitation "said motor operating voltage" lacks antecedent basis.
- Claim 64 should be canceled. Claim 1 clearly defines "A system for driving a direct-current (DC) motor", see line 1. Thus, the DC motor is inside the system. Claim 64 cannot further define "...comprising a DC motor" unless this DC motor is different from the DC motor of claim 1. If the DC motor of claim 64 is different from the DC motor of claim 1, then claim 64 should change to "The system according to claim 47, further comprising a second DC motor". If the DC motor of claim 64 is in fact same as the DC motor of claim 1, then claim 64 should be canceled.
- If claim 64 is canceled, the dependency of claim 65 should be changed.
- Claim 94, lines 1-2, the recitation "..., further comprising an electronically driven motor," should be changed to --....., wherein the DC motor is an electronically

driven motor--. This change is required because there is only one DC motor and the one DC motor is an electronically driven DC motor (or a brushless DC motor). See applicant's disclosure and drawings.

- Claim 101 has the same problem as that of claim 94. Claim 101 should be amended in the same manner as that of claim 94.
- Claim 50, between lines 18 and 19, change the phrase "and not part of the said DC motor main magnetic circuit," to --and not part of the said DC motor main magnetic circuit,--.
- Claim 108 has the same problem as that of claim 94. Claim 108 should be amended in the same manner as that of claim 94.
- Claim 109, between line 2 and line 3, the recitation "said motor operating voltage" lacks antecedent basis.
- Claim 109, lines 11-12, the recitation "said DC motor main magnetic circuit" lacks antecedent basis.
- Claim 114 should be canceled or re-written to at least two separate dependent claims. First, the elements defined in the dependent claim cannot **replace** the elements defined in the independent claim. With this regard, the dependent claim with "replaced" elements should be re-written as an independent claim or the claim should be canceled. Secondly, the dependency of claim 114 is unclear. First line of claim 114 defines the dependency to be "claim 109". However, lines 3-4 of claim 114 further recites "...or to a high impedance for a period of time determined by said control system controlling said first switch in

claim 93.” It is noted that claim 114 does not depend on claim 93 which causes this recitation unclear. More importantly, claim 114 contains several independent sentences. Each independent sentence starts with a capital letter and ends with a period. A claim contains several independent sentences is not acceptable. A claim must be a complete sentence and started with a capital letter and ended with a period. Claim 114 does not meet this requirement. In view of the foregoing reasons, claim 114 should be canceled.

- Claim 115 has the same problem as that of claim 94. Claim 115 should be amended in the same manner as that of claim 94.
- Claim 116, between line 2 and line 3, the recitation “said motor operating voltage” lacks antecedent basis.
- Claim 116 has defined two “DC voltage source”, one on line 2 and the other on line 13. If the two DC voltage sources are different, differentiation is required. If the two DC voltage sources are in fact a single one, correlation is required.
- Claim 116, between line 19 and line 20, the recitation “and not part of the said DC motor main magnetic circuit,” should be changed to --and not part of the said DC motor main magnetic circuit,--.
- Claim 123 has the same problem as that of claim 94. Claim 123 should be amended in the same manner as that of claim 94.

All other claims not mentioned above are rejected because they depend on the rejected claims.

3. Claims 49, 95-100 are allowable.
4. Claims 47, 48, 50-53, 55-57, 64-68, 84-86, 93, 94, 101-123 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
5. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2837

Any inquiry concerning this communication should be directed to BENTSU RO at telephone number (571)272-2072.

/BENTSU RO/
Primary Examiner, Art Unit 2837